IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Klaus Huenlich et al.
Appl. No.: 09/936,444
Conf. No.: 4127
Filed: September 11, 2001
Title: METHOD FOR DATA TRANSMISSION VIA A PACKET-ORIENTED
COMMUNICATION NETWORK
Art Unit: 2616
Examiner: Habte Mered
Docket No.: 112740-262

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This request is submitted in response to the Final Office Action dated March 23, 2006. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

Remarks begin on page 2 of this paper.

Application No.: 09/936,444
Notice of Appeal and Pre-Appeal Brief Request
Responsive to Final Rejection dated March 23, 2006

REMARKS

Claims 11-20 are pending in the present application. Independent claim 11 and dependent 19 are the focus of this request.

Claim 11, along with dependent claims 12-14, 16, 19 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Song* (US Patent No. 6,289,018) in view of *Madonna* (US Patent No. 5,737,320). Claim 15 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Song* (US Patent No. 6,289,018) [in view of *Madonna* (US Patent No. 5,737,320)], in view of *Geiger et al.* ("Integrated Circuits for ISDN Status and Future," April 1989, IEEE) Claims 17-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Song* (US Patent No. 6,289,018) [in view of *Madonna* (US Patent No. 5,737,320)], in view of *Dualt et al.* (US Patent 6,108,336). Applicant respectfully submits the rejections are improper and requests reversal by this board.

Claim 11 discloses a method to transmit time-slot oriented data via a packet-oriented communications network. The time-slot oriented data comprises (1) information segments for transmitting signaling information, (2) information segments for transmitting user data information, and (3) information segments for transmitting data-format-specific information. For example the time-slot oriented data can be ISDN data in the IOM-2 data format, wherein the M-, C/I-, MR-, and MX-segments of that IOM-2 data format are data-format-specific information, because these segments are used for hardware or transport interaction between the ISDN communications devices. Claim 11 recites that the three different groups of information segments are transmitted in separate data packets via the packet-oriented communications network. Specifically, the information segments intended for transmitting the signaling information are transmitted in first data packets, the information segments intended for transmitting the user data information are transmitted in second data packets, and the information segments intended for transmitting the data-format-specific information are transmitted in third data packets.

In contrast, *Song* fails to teach these features. Instead, *Song* discloses splitting ISDN B- and D-channels, multiplexing the B-channels into B-channel-specific ATM packets, and multiplexing the D-channels into D-channel-specific ATM packets (FIG. 5, col. 2, lines 45-67).

2

Application No.: 09/936,444
Notice of Appeal and Pre-Appeal Brief Request
Responsive to Final Rejection dated March 23, 2006

More Specifically, *Song* discloses a splitting of B- and D-channels and multiplexing the split B- and D-channel data to corresponding highways (see Abstract, Fig. 5-7; col. 7, lines 43-52). The sorted B- and D-channel data is then assembled in ATM cells based on destinations (see Abstract; col. 9, lines 26-37). This clearly contradicts the recited features in the present claims that group information segments according to the type of information used (i.e., signaling data, user data, data-format specific data). By grouping data by destination, this configuration would lead to the assembling of signaling, user data, and data-format specific segments with the same destination into a common ATM cell, instead of separating them and transmitting them separately in different data packets. The multiplexers 123 and 124 of *Song* are disclosed as performing an intermediate sorting of B- and D-channel data (col. 7, lines 52-59), but does not provide a teaching or suggestion that these channels are separately transmitted in first and second data packets, or in first, second, and third data packets, grouped by the type of information (signaling, user data, data-format specific).

Regarding *Madonna*, the reference (see Fig. 1E; col. 7, line 46- col. 8, line 24) discloses various types of packets which may be used to transfer information over networks. Under *Madonna*, a packet may have a status&control portion and a further control portion besides a payload portion. However, *Madonna* does not teach or suggest "transmitting information segments [intended for transmitting the data-format-specific information] in third data packets that are intended for data transmission via the packet-oriented communications network."

Moreover, there is no teaching or suggestion to combine the references in the manner suggested in the Office Action. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among

Application No.: 09/936,444
Notice of Appeal and Pre-Appeal Brief Request
Responsive to Final Rejection dated March 23, 2006

isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

The cell assembly and disassembly module (CLAD) 130 of *Song* provides a configuration that teaches away from the presently disclosed features, as the CLAD relies on a complex routing control (col. 9, line 60 - col. 10, line 7; see Fig. 9) that allocates one cell header and one routing tag for each ATM cell according to destination. The stated motivation provided in the Office Action that splitting the data into types would "[make] it easier for a processor to identify and process a given packet as it is easier to pick a specific control segment rather than going through an augmented huge control field" is lost on the Applicant. At best, the contrary is true, as this would severely complicate the system of *Song* with regard to the "control" and "status&control" signals disclosed in *Madonna*, and nevertheless fails to provide for a third separate data packet as disclosed in the claims.
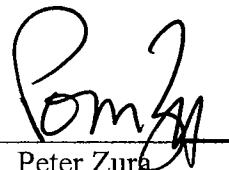
Moreover, the configuration taught in *Madonna* focuses on a <u>receiving</u> side of a transmission (see col. 3, line 58 - col. 4, line 12), whereas *Song's* disclosure almost completely focuses on the <u>sending</u> side (see col. 3, lines 2-16). The significance of this is that different considerations are taken into account for each end to address unique transmission requirements. In *Madonna*, the routing of packets occurs under a ESFR/FSER configuration where the packets either (1) send "empty" packets and receive "full" packets in return (ESFR), or (2) send "full" packets and receive "empty" packets in return (FSET) (col. 3, line 58 - col. 4, line 36; col. 14, lines 44-63) to maintain node independence. In contrast, *Song* discloses that a none of the timeslots having the same number should be empty at all times (col. 9, lines 39-40). The Office

Application No.: 09/936,444
Notice of Appeal and Pre-Appeal Brief Request
Responsive to Final Rejection dated March 23, 2006

Action does not reconcile how the two systems would be integrated, given the teaching of each reference.

Regarding claim 19, neither the D-channel MUX and the B-channel MUX nor anywhere in the disclosure does *Song* teach or suggest the use of a tie line (i.e., a fixed connection) for transmitting the information segments intended for transmitting the signaling information. Moreover, no teaching or suggestion can be found to use a tie line for transmitting the signaling information given the disclosure of the cited art.

In light of the above, Applicant respectfully submits that independent claim 11 of the present application, as well as all claims which respectfully depend therefrom, are both novel and non-obvious over the art of record. Accordingly, Applicant respectfully requests the rejection be reversed and that a timely Notice of Allowance be issued in this case. If any fees are due in connection with this application as a whole, the office is hereby authorized to deduct said fees from Deposit Account No.: 02-1818.

Respectfully submitted,
BELL, BOYD & LLOYD LLC

BY _____
Peter Zura
Reg. No. 48,196
Customer No.: 29177
Phone: (312) 807-4208

Dated: June 23, 2006